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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/440,243	11/15/99	LIEBENOW F	450.264US1

MMC1/0129
SCHWEGMAN LUNDBERG WOESSNER AND KLUTH PA
P O BOX 2938
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EXAMINER	
EICKHOLT,E	
ART UNIT	**PAPER NUMBER**
2854	

DATE MAILED: 01/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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09/440,243

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/440,243	11/15/99	LIEBENOW	

EXAMINER

ART UNIT: 1764 | PAPER NUMBER: 4

MMC2/0129
SCHWEGMAN LUNDBERG WOESSNER AND KLUTH PA
P O BOX 2938
MINNEAPOLIS MN 55402

DATE MAILED: 01/29/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☑ Responsive to communication(s) filed on 12-27-00

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☑ Claim(s) 1-30 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☑ Claim(s) 1-30 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☑ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

–SEE OFFICE ACTION ON THE FOLLOWING PAGES–

★ U.S. GPO: 1998-404-498/40512

Election of species requirement stands withdrawn in view of the legal admission against interest by counsel that 'the inventions are so closely related they cannot be properly considered independent and distinct" meaning if any of the species are found unpatentable over prior art then that art is presumed valid against all the other claims without need for further analysis.

Claims 1 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims are vague, indefinite and/or incomplete.

If the color designation is overridden (i.e. canceled) how can the next step of printing occur, absent a step of substitution of a different color designation.

Claims are further vague as to whether or not the subset is printed as part of the printable information units when printing occurs.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al in view of Narendranath et al.

Rivetti et al teaches creation of an "Equivalent File".

This file is an electrically stored data file which can be created to have areas, such as Figure numbers, highlighted by user choice in a color different than the usual default color (black). The example is given of uses made of such a file by a patent attorney.

One of ordinary skill in the printing arts, a complex art, is considered to be a clever attorney devil. As such, it would have been obvious and a routine and regular business event for the patent attorney to have used a multi-color printer to print out the "Equivalent File". See column 5, lines 1-10, which clearly imply printing of the ""Equivalent File". The secondary reference to Nerendarath at al is merely cited to show a printer capable of single or multicolor printing.

Claim 2 calls for changing from a non-black to a blacl color for high lighting a subset. Thus would obviously be a default color choice of design by the original document maker. Claim 3 is suggested by column 3,lines 46-50 which refers to "no human intervention to obtain a usable Equivalent File".

Claims 4-11 and 15-30 are by default considered obvious over the above stated art combination in view of counsels admission against interest that the species claims of the invention are so closely related they cannot be properly considered independent and distinct.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. A shortened statutory period of 3 months is set to respond

eickholt/ds

EUGENE EICKHOLT
PRIMARY EXAMINER